

REMARKS

Claims 22-42 are pending and under current examination. In the Office Action, the Examiner took the following actions:

- (a) objected to the drawings as containing hand written labels and empty boxes;
- (b) objected to claims 28 and 37 for informalities;
- (c) rejected claim 42 under 35 U.S.C. § 101; and
- (d) rejected claims 22-42 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2005/0060542 A1 (“*Risan*”).

I. Objection to the drawings

The Office Action objected to the drawings because they “contain hand written labels and/or square/rectangular empty boxes.” Office Action, p. 2. Specifically, the Office Action required “that Applicant removes the hand written labels and provides a clear description in each of the empty boxes.” *Id.* In response, Applicant submits five (5) replacement drawing sheets of amended Figs. 1-3, 4a-4d, 5, and 6, with appropriate descriptive legends in the block diagrams and typeset labels, in compliance with 37 C.F.R. § 1.84(o). No new matter has been added. Accordingly, Applicant requests that the replacement drawing sheets be made of official record in the above-identified application, and requests withdrawal of the objection.

II. Objection to claims 28 and 37

The Office Action alleged that the word “valuating” in claim 28 is misspelled. *See* Office Action, p. 3. Applicant respectfully disagrees, and points out that “valuating” (spelled as such) is a proper form of the verb “to value.” Usage of the term, consistent with this meaning, can be found in the Specification at, for example, p. 20, line 8.

The Office Action also alleged that the word “apt” in claim 37 is misspelled. *See* Office Action, p. 3. While Applicant respectfully disagrees on the basis that “apt” is a proper English word that fits in the context of the claim language, without waiving any arguments, Applicant nevertheless adopts the Office’s suggestion to replace the word “apt” with “adapted.”

III. Rejection of claim 42 under 35 U.S.C. § 101

The Office Action rejected claim 42 as being “directed to non-statutory subject matter.” Office Action, p. 3. In response to this rejection, and without conceding to the Office Action’s arguments regarding alleged non-statutory subject matter, Applicant has amended claim 42 to recite a computer readable medium encoded with a computer program product. Applicant submits that this amendment overcomes the 35 U.S.C. § 101 rejection, and accordingly respectfully requests its withdrawal.

IV. Rejection of claims 22-42 under 35 U.S.C. § 102(e) over *Risan*

Applicant requests reconsideration and withdrawal of the rejection of claims 22-42 under 35 U.S.C. § 102(e) as being anticipated by *Risan*. In order to establish anticipation under 35 U.S.C. § 102, the Office Action must show that each and every element as set forth in the claims is found, either expressly or inherently, in *Risan*. *See* M.P.E.P. § 2131. *Risan*, however, does not disclose each and every element of Applicant’s claims, despite the Office Action’s allegations that *Risan* discloses each and every element of claims 22-42. *See* Office Action, pp. 3-6. Applicant contends that the Office Action has mischaracterized *Risan*.

In particular, Applicant notes that the Office Action repeatedly refers to *Risan*’s disclosed “web server” and “user ID/key” with citation to *Risan* at paragraphs 65-66, 89-91, 160-63, etc. *See id.* From this premise, the Office Action then attempts to fit *Risan*’s disclosure to the claimed “user modeling server” and “user profile” recited in independent claims 22 and 32.

It does not appear that the Office Action considered Applicant's usage and definition of the claimed "user modeling server" and "usage data" as set forth in the specification at, for example, p. 2, ll. 1-32, and p. 8, l. 3 to p. 9, l. 7. As to Applicant's claimed "user modeling server," *Risan* does not teach a server "providing the user modeling functionality," which includes starting "an inference algorithm" "in order to build the user model associated to the given pseudonym" and specifically "calculate[] the preferences of the user." Specification at p. 8, l. 28 and p. 9, ll. 30-32. Instead, *Risan* teaches "a web server" which "can determine when a user of one computer system" "has given their username and password to another user using another computer system," thereby preventing "unauthorized access to copyrighted media content." *Risan* at ¶ 68. Therefore, *Risan* does not disclose at least Applicant's claimed "user modeling server," as recited in claim 22.

As to Applicant's claimed "usage data," *Risan* does not teach "the collection of information about the user and providing inferential capabilities for the estimation of the user's skills and preferences . . . developed in the tutoring area e.g. by means of a learner modeling server providing multiple (software) teaching agents with information about the user's knowledge." Specification at p. 2, ll. 19-23. Instead, *Risan* teaches a collection of information comprising "the user's name, the user's address, the user's credit card number, an online payment account number, a verified email address, and an identity (username) and password selected by the user" and/or "biometric data," including "fingerprint data, retinal scan data, handprint data, facial recognition data, and the like." *Risan*, ¶¶ 65-66. Therefore, *Risan* also does not disclose at least Applicant's claimed "usage data," as recited in claim 22.

Thus, *Risan*'s "web server" and "user ID/key" do not constitute the claimed "user modeling server" and "usage data," as described and claimed by the Applicant.

Applicant respectfully points out that, under U.S. practice, applicants may define claim terms (such as the claimed “user modeling server”) as they choose in the specification. The M.P.E.P. states that “where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.” M.P.E.P. § 2111.01(IV), 8th ed., rev. 6 (Sept. 2007), p. 2100-41 (citing *Toro Co. v. White Consol. Indus. Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) for holding that the meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”). In particular, though any special meaning “must be sufficiently clear in the specification,” “the meaning of a term may be defined by implication . . . according to the usage of the term in the context in the specification.” *Id.*

Applicant defines the claimed “user modeling server” and “usage data” as they appear in the specification, for example, at pages 2, 8 and 9, which highlight clear differences between *Risan*’s “web server” and the claimed “user modeling server;” and *Risan*’s “user ID/key” and the claimed “usage data,” as recited in independent claims 22 and 32.

Since *Risan* does not disclose each and every element of independent claims 22 and 32, *Risan* does not anticipate claims 22 and 32 under 35 U.S.C. § 102(e). Therefore, claims 22 and 32 should be allowable over *Risan*. Dependent claims 23-31 should also be allowable at least due to their dependence from base claim 22; and dependent claims 33-42 should also be allowable at least due to their dependence from base claim 32. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 22-42 under 35 U.S.C. § 102(e).

V. Conclusion

Applicant respectfully requests reconsideration of this application and withdrawal of the objections and rejections. Pending claims 22-42 are in condition for allowance, and Applicant requests a favorable action.

The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

If there are any remaining issues or misunderstandings, Applicant requests that the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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